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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/009,846	01/20/98	ZAMBIAS	R 5925-051-999

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HM21/1123

EXAMINER
ACHUTAMURTHY, P

ART UNIT	PAPER NUMBER
1648	

DATE MAILED: 11/23/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/009,846

Applicant(s)
Robert Zambias et al

Examiner
P. Achutamurthy

Group Art Unit
1648



☒ Responsive to communication(s) filed on Sep 26, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-15 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-15 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claim Rejections - 35 USC § 112

Rejection A

Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for specific compounds disclosed in the specification, does not reasonably provide enablement for compound arrays comprising molecular constructs of undefined and unspecified chemical characteristics.. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. It is noted that specific building blocks are used which have functionalities that will enable attachment of certain specific chemical moieties are taught in the specification. However, without any delineation of the types of compounds in the array persons having ordinary skill in the art would not be able to make compound arrays without knowing what starting core compound and what diversity elements are to be employed, in the absence of adequate guidance from the instant specification.

Response to Amendment/Arguments

Applicant's arguments filed August 26, 1998 have been fully considered but they are not persuasive.

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It is initially noted the terminal disclaimer filed August 26, 1998 has been received and entered; accordingly the double-patenting rejections B, C, and D are hereby withdrawn.

With respect to rejection A, however, the amendments to the claims do not obviate the rejection because the common molecular cores used to obtain the compounds are recited so broadly as to not only render the instant specification nonenabling but also fail to clearly define the meets and bounds of the claims. The core moieties are recited to be any one having linear, branched, or cyclic, compounds comprising at least three atoms of carbon, nitrogen, oxygen, phosphorous or sulfur would encompass compounds ranging from the simplest one such as propane (three carbon atoms) to the most complex including large heterocyclic and macrocyclic moieties since there is no upper limit to the total number of atoms that can be present. Such generic description includes virtually incalculable number of molecular cores and there is simply no adequate guidance in the specification as to how to select specific compounds from such an extremely large number and know in what manner any undefined structural diversity element can be attached to the core molecule in order to obtain a library of at least ten different compounds. Even if the level of skill in the art is high and persons skilled in the art would have knowledge of attaching certain known functionalities such as amine, carboxyl etc, one would not be able to select and make the compounds that may be encompassed in the recited arrays without an undue amount of experimentation.

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Information Disclosure Statement

The Information Disclosure Statement submitted May 12, 1998 is acknowledged. Applicants state that copies the references cited in the IDS (form 1449) were provided in copending application serial number 09/009,844. Examiner will send a signed copy of the 1449 from after reviewing the reference in the next office action.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to **Group Art Unit 1648**.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Achutamurthy whose telephone number is (703) 308-3804. The examiner can normally be reached on Monday-Thursday from 7:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald E. Adams, Ph.D., can be reached on (703) 308-0570. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

pa
November 22, 1998


PONNATHAPURA ACHUTAMURTHY
PRIMARY EXAMINER
GROUP 1800